

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 20, 23, and 28-30 have been amended, claims 6-7, 14, 16-19, 21, and 31-33 have been cancelled without prejudice, and new claims 38-49 have been added. Support for any new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC Section 103

Claims 1-5, 8-9, 29, 36, and 37 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent application publication 2003/0123079 to Yamaguchi et al. ("Yamaguchi") in view of U.S. patent 6,122,657 to Hoffman Jr. et al. ("Hoffman"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 1 and 29, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

As to a rejection under 103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5

U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the Office has not established a *prima facie* case of obviousness because the applied references do not teach or suggest all of Applicant's claim limitations, there is no suggestion or motivation to modify the reference or to combine reference teachings, and there is no reasonable expectation of success.

Independent claim 1 (amended), and its dependent claims 2-5, 8-9, and 36-37, are patentably distinguishable over the cited references because claim 1 emphasizes the novel features of the present invention which filters image files so as to exclude relatively smaller files and include relatively larger files in a set of qualified image files. In this regard, claim 1 recites:

"1. (Currently amended) A method of printing with a printing system, comprising:
analyzing a web page with the printing system to identify image files associated with the web page;

filtering the image files with the printing system according to predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files, the predefined criteria excluding relatively smaller ones of the image files from the qualified image files and including relatively larger ones of the image files in the qualified image files;

selecting at least one of the qualified image files; and
printing the selected ones of the qualified image files." (emphasis added)

The Office admits that "Yamaguchi does not disclose expressly filtering the image files

with the printing system according to predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files” (Office Action, p.5). Furthermore, the Office states that the Hoffman reference discloses such a limitation (Office Action, p.5). However, Applicants believe that the Hoffman reference does not disclose that the predefined criteria exclude relatively smaller ones of the image files from the qualified image files, nor include relatively larger ones of the image files in the qualified image files.

The Hoffman reference describes “methods for speeding up the process of browsing Web content in a computer system having an Internet or other on-line browser” (col. 1, lines 23-25).

The Hoffman reference explains that:

“Accompanying the explosive growth of the World Wide Web, for instance, is the ever increasing use of advertising material on practically any content which a user can access. This is particularly problematic since advertising material is often graphically intensive, requiring substantial time and resources for downloading and processing. Apart from advertising, many Web sites employ graphics to such an extreme degree as to render it difficult or impractical to access the Web site in real-time unless one has a high-speed Internet connection (e.g., T1 line). All told, the total download times for Web pages is becoming increasingly greater. ... Accordingly, there is great interest in developing techniques which speed up the process of browsing Web content or "Web surfing," including decreasing the background noise (e.g., ancillary graphics) which are not desired by the user.” (col. 2, lines 45-67; emphasis added)

In order to speed up the process of browsing Web content according to the Hoffman reference, “[a]t each client, interposed (functionally) between the browser and the communication layer is a Filter module of the present invention. In this fashion, the Filter module can trap and process all communications between the browser and the communication layer” (col 3, lines 26-28). The Hoffman reference teaches:

“At a high level, the Filter module operates as follows. The Web browser retrieves content by generating requests for content. More particularly, a fetch or GET request or command (e.g., using HTTP protocol) is issued through the Winsock communication driver, for example, for fetching particular content (e.g., bitmaps) specified by a Web page. The command is, however, first trapped by the Filter module. The "real" request or command is at this point processed by the Filter method. At the level of the Filter method, the system can modify the

command, delete the command, synthesize new commands, or pass through unchanged the existing command, thereby impacting how the system renders Web pages.” (col. 3, lines 39-51)

With regard to the filtering of image files in particular, the Hoffman reference teaches:

“If the Filter is configured to kill ads or kill images larger than a preselected image size (tested at line 506), the method proceeds as follows. The method establishes a network connection. At this point, the server is queried for determining the image size. If the image size exceeds a maximum image size desired by the user, the image will be killed. ... [T]he image is killed at lines 611-617 in the event that it exceeds a maximum image size. If, on the other hand, ... the image does not exceed a maximum size, the image is passed through without filtering.” (col 30, lines 23-46; emphasis added)

The above-described operation allows the Hoffman reference to speed up the process of Web browsing by not fetching and rendering large image files when displaying a web page.

Applicants’ invention, however, is not directed to speeding up the process of Web browsing but rather to “a printer and printing method that allows digital images associated with Internet web pages to be previewed, selected, and printed without the need for attaching a computer to the printer” (p.3, lines 18-20). In operation, “the web page is acquired and analyzed to identify image files associated therewith. The image files are filtered according to qualifying criteria, and one or more are selected for printing. The selected images are then obtained and printed” (p.7, lines 3-6). Some of the images associated with web pages may not be suitable for photographic quality printing, because of their small size. Accordingly, “since small images that must be scaled up to photographic print sizes generally will not produce a print 26 with high image quality, the rendered image size filter criteria 76c might be set to filter out files with less than a specified height, width, or combination thereof” (p.18, lines 2-5). Similarly, “[t]he image file size filter criteria 76b can be used in a similar manner to the rendered image size filter criteria 76c, but typically with more confidence as to the probability that the image file 4 will produce a print 26 of high quality” (p.19, lines 6-9). In other words, according to the limitations of claim 1, the printing system filters the image files according to predetermined criteria that are indicative of at least one file characteristic, so as to identify certain ones of the image files as qualified image files. The predefined criteria exclude relatively smaller

ones of the image files from the qualified image files, and include relatively larger ones of the image files in the qualified image files.

Such a limitation is the opposite of what is taught by the combination of the Yamaguchi and Hoffman references. Therefore, the features of the present invention are neither disclosed nor suggested by the Yamaguchi reference in combination with the Hoffman reference.

In addition, there is no reasonable expectation of success in combining the references to achieve Applicant's invention as recited in claim 1. Applying the filtering of the Hoffman reference to the Yamaguchi reference would result in filtering out the larger, photographic-quality images, which are the ones the user wishes to be able to select to print. As a result, the user would not be able to select these larger, photographic-quality images for printing.

Furthermore, by filtering out the larger, photographic-quality images instead of the smaller ones, the Yamaguchi and Hoffman references teach away from Applicants' invention as recited in claim 1.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 29 (currently amended) recites limitations similar to those of claim 1, discussed above.

Claim 29 recites:

"29. (Currently amended) A printing system, comprising:
 means for analyzing a web page with the printing system to identify image files associated with the web page;
means for filtering the image files with the printing system according to qualifying criteria indicative of at least one image file characteristic so as to identify certain ones of the image files as qualified image files, the qualifying criteria causing relatively smaller ones of the image files to be excluded from the qualified image files and relatively larger ones of the image

files to be included in the qualified image files;

means for selecting at least one of the qualified image files for printing; and
means for printing the at least one selected one of the image files.” (emphasis added)

For similar reasons as explained heretofore with regard to claim 1, the features of the present invention as recited in claim 29 are not taught or suggested by the cited references in that the features of means for filtering image files according to qualifying criteria that cause relatively smaller image files to be excluded and relatively larger image files to be included in a group of qualified image files are neither taught nor suggested by the Yamaguchi reference in combination with the Hoffman reference. Also for similar reasons as explained heretofore with regard to claim 1, there is no reasonable expectation of success in combining the references to achieve Applicant’s invention as recited in claim 29, and the Yamaguchi and Hoffman references teach away from Applicants’ invention as recited in claim 29.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Claims 20, 22, and 30 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,141,111 to Kato (“Kato”) in view of U.S. patent application publication 2003/0123079 to Yamaguchi et al. (“Yamaguchi”) and further in view of U.S. patent 6,942,150 to Knowles (“Knowles”). The Office has not established a *prima facie* case of obviousness because the applied references do not teach or suggest all of Applicant’s claim limitations. Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 20 and 30, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Independent claim 20 (amended), and its dependent claim 22, are patentably distinguishable over the cited references because claim 20 emphasizes the novel features of the present invention which automatically filter image files based on an image size characteristic to identify relatively larger image files as qualified image files but exclude relatively smaller files. In this regard, claim 20 recites:

“20. (Currently amended) A method of printing with a multifunction printing system, comprising:
automatically analyzing a web page to identify image files associated with the web page;
automatically filtering the image files based on an image size characteristic so as to identify relatively larger ones of the image files as qualified image files and to exclude relatively smaller ones of the image files from the qualified image files;
printing a proof sheet for at least some of the qualified image files, the proof sheet having an image identifier, at least one identity marker indicative of a web location for each of the at least some of the qualified image files, and at least one corresponding selection area for each of the at least some of the qualified image files;
marking at least one of the selection areas corresponding to at least one of the qualified image files to be printed;
optically scanning the marked proof sheet so as to determine marked selection areas;
determining from the at least one identity marker the web location for those ones of the qualified image files associated with the marked selection areas; and
printing the qualified image files associated with the marked selection areas.” (emphasis added)

As discussed heretofore with reference to claim 1, the Office admits that the Yamaguchi reference does not disclose filtering the image files with the printing system.

The Kato reference discloses a “designation medium to designate a first information designating image to be printout to recording media out of those images taken by a digital still camera” (Abstract). The Kato reference is cited by the Office as to printing a proof sheet, marking it, optically scanning it, and printing image files. However, the Office admits that “Kato does not disclose expressly automatically analyzing a web page to identify image files associated with the web page” (Office Action, p.10). It follows that Kato could not automatically filter these image files based on an image size characteristic. No such capability is disclosed in the Kato reference.

The Knowles reference discloses “URL-encoded bar code symbols printed on various types of print media which, when read thereby, automatically connects the Internet Client System to the Internet Server supporting the Web-site specified by the scanned URL-encoded bar code symbol” (Abstract). The Knowles reference is cited by the Office with regard to an identity marker on the proof sheet. However, the Knowles reference merely discloses the use of the bar code symbol for “surfing to Web-sites on the Internet by optically scanning the character strings of URLs into GUI-based web browser programs, without the need of manual data entry operations” (col. 3, lines 56-60); it does not disclose any analysis or filtering of the web page to which it has surfed.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 30 (amended) is patentably distinguishable over the cited references because claim 30 emphasizes the novel features of the present invention which prints a proof sheet for qualified image files, where the qualified image files are identified by matching a filter criterion with textual information that is associated with the qualified image files but separate from a URL of the qualified image files. In this regard, claim 30 recites:

“30. (Currently amended) A multifunction printing system, comprising:
 means for automatically analyzing a web page with the printing system to identify image files associated with the web page;
means for printing a proof sheet for qualified ones of the image files, the proof sheet having an image identifier, at least one identity marker indicative of a web location for the qualified image files, and at least one corresponding selection area for each of the qualified image files, each qualified one of the image files identified by matching a filter criterion with textual information associated with the qualified one of the image files but separate from a URL of the qualified one of the image files;
 means for scanning the marked proof sheet after user-marking of at least one of the

selection areas corresponding to at least one of the qualified image files to be printed so as to determine marked selection areas; and

means for determining from the at least one identity marker the web location for those ones of the qualified image files associated with the marked selection areas; and

means for printing the qualified image files associated with the marked selection areas.”
(emphasis added)

For example, as explained with regard to Applicants’ invention,

“The textual information filter criteria 76e ascertains and uses textual information associated with the image file 4 for filtering purposes. The textual information is preferably indicative of the nature of the image. The textual information may be contained in a header portion of the image file 4 as is, for example, frequently done with JPG files. The textual information may also be contained in a shadow file having the same web page URL 73 as the image file 4, except for a different predetermined file extension, such as ".txt". The textual information may alternatively be derived from a contextual analysis of the HTML markup text of web page 8. For example, many web pages 8 include a caption or other explanatory information adjacent an image 6, and by analyzing the way the web page 8 will be spacially rendered by a web browser, the textual information related to the image file 4 for the image 6 can be ascertained. Once the textual information is obtained, filtering can be done in a similar manner as has been described” (specification, p.19, line 12 – p.20, line 2; emphasis added).

For similar reasons as explained heretofore with reference to claim 20, neither the Yamaguchi, Kato, or Knowles reference, alone or in combination, identify qualified images from among the image files associated with a web page by matching a filter criterion with textual information that is associated with the qualified image files but separate from the URLs of the qualified image files, as recited in claim 30.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Claims 23-26 and 28 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,141,111 to Kato ("Kato") in view of U.S. patent 6,122,657 to Hoffman Jr. et al. ("Hoffman"). The Office has not established a *prima facie* case of obviousness because the applied references do not teach or suggest all of Applicant's claim limitations. Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 23 and 28, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Independent claim 23 (amended), and its dependent claims 24-26 and 28, are patentably distinguishable over the cited references because claim 23 emphasizes the novel features of the present invention in which an image proofing subsystem forms a user-markable proof sheet for certain of the image files associated with a web page that have a relatively larger size than other ones of the image files that are omitted from the proof sheet. In this regard, claim 23 recites:

"23. (Currently amended) A multifunction printing system, comprising:

a web page analyzer subsystem for identifying image files associated with a specified web page and for obtaining certain of the image files that satisfy filter criteria indicative of at least one image file characteristic, the certain ones of the image files having a relatively larger size than other ones of the images files;

an image proofing subsystem coupled to the web page analysis subsystem for forming a user-markable proof sheet having an indicia of each of the certain image files and a user-designation area associated with each indicia, the other ones of the image files omitted from the proof sheet;

a proof sheet analyzer subsystem adapted to identify the user-designated ones of the certain image files from the marked proof sheet and obtain the user-designated ones of the certain image files; and

an image printing subsystem coupled to the proof sheet analyzer subsystem for printing the user-designated ones of the image files." (emphasis added)

For similar reasons as explained heretofore with regard to claims 1 and 20 respectively, neither the Hoffman reference nor the Kato reference, either alone or in combination, disclose filter criteria that select certain ones of the image files that have a relatively larger size for inclusion on a user-markable proof sheet, but omit from the proof sheet other ones of the image

files that do not have a relatively larger size. Also for similar reasons as explained heretofore with regard to claim 1, there is no reasonable expectation of success in combining the references to achieve Applicant's invention as recited in claim 23, and the Kato and Hoffman references teach away from Applicants' invention as recited in claim 23.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Dependent claim 28 is further patentably distinguishable over the cited references because claim 28 emphasizes the novel features of the present invention in which the filter criteria includes a file type of the image file. Claim 28 recites:

"28. (Currently amended) The system of claim 23, wherein the filter criteria include a file type of the image file." (emphasis added)

For example, as explained with regard to Applicants' invention,

"Filtering criteria corresponding to some image file characteristics, such as image file type filter criteria 76a ... for the web page images 4, can be performed based on the web page HTML source. For example, since GIF files often contain small icons and buttons rather than photographic images, the image file type filter criteria 76a might be set to filter out GIF files." (specification, p.17, line – p.18, line; emphasis added)

For similar reasons as explained heretofore with regard to claims 1 and 20 respectively, neither the Hoffman reference nor the Kato reference, either alone or in combination, disclose filter criteria that select certain ones of the image files that have a relatively larger size for inclusion on a user-markable proof sheet, but omit from the proof sheet other ones of the image files that do not have a relatively larger size, based on the file type of the image file.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed

features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that additional reason and should be withdrawn.

Dependent claims 10, 13, 15, and 35 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent application publication 2003/0123079 to Yamaguchi et al. ("Yamaguchi") in view of U.S. patent 6,122,657 to Hoffman Jr. et al. ("Hoffman"), and further in view of U.S. patent 6,141,111 to Kato ("Kato"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of these claims on independent base claim 1, whose reasons for allowability over the Yamaguchi and Hoffman references have been discussed heretofore and against which the Kato reference has not been cited.

Dependent claim 11 has been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,141,111 to Kato ("Kato") in view of U.S. patent application publication 2003/0123079 to Yamaguchi et al. ("Yamaguchi"), further in view of U.S. patent 6,122,657 to Hoffman Jr. et al. ("Hoffman"), and still further in view of U.S. patent 6,784,925 to Tomat et al. ("Tomat"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of this claim on independent base claim 1, whose reasons for allowability over the Yamaguchi and Hoffman references have been discussed heretofore and against which the Kato and Tomat references have not been cited.

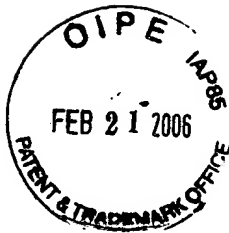
Dependent claim 12 has been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,141,111 to Kato ("Kato") in view of U.S. patent application publication 2003/0123079 to Yamaguchi et al. ("Yamaguchi"), further in view of U.S. patent 6,122,657 to Hoffman Jr. et al. ("Hoffman"), still further in view of U.S. patent 6,784,925 to Tomat et al. ("Tomat"), and even further still in view of U.S. patent 6,942,150 to Knowles ("Knowles "). Applicants respectfully traverse the rejection and request reconsideration based on

the dependence of this claim on independent base claim 1, whose reasons for allowability over the Yamaguchi and Hoffman references have been discussed heretofore and against which the Kato, Tomat, and Knowles references have not been cited.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.



HP Docket No. 10011763-1

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

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